

Remarks

Favorable reconsideration of this application is requested in view of the following remarks. For the reasons set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

The Final Office Action dated February 19, 2003, indicated that claims 1-6 and 9-14 stand rejected under §102(e) as being anticipated by *Wiesler et al.* (U.S. Publication No. US2001/0047222); and claims 8 and 15 stand rejected under §103(a) as being unpatentable over *Wiesler et al.* in view of *Terao* (U.S. Patent No. 5,191,535).

None of the rejections present a *prima facie* case because the '222 publication still does not constitute prior art. The Examiner's citation to 37 C.F.R. §1.14(c)(1)(i) is to a permissive rule which indicates how Applicant may obtain a copy of the provisional document. However, the patent statutes and rules mandate that the Examiner provide any such provisional patent document relied upon and/or used to support the rejection(s). *See*, 35 U.S.C. §132 and 37 C.F.R. §1.104. At page 6 of the Office Action, the Examiner acknowledges that he has relied upon the provisional filing date of the '222 publication. Moreover, the Examiner's after final invitation to request the provisional patent document via §1.14(c)(1)(i) has foreclosed Applicant's ability to timely respond to the rejections and is a clear violation of the above-noted patent statutes and rules. Thus, the rejection, as well as its finality, must be withdrawn.

Moreover, the Office Action fails to show that the '222 publication completely corresponds to the claimed invention. The claimed invention is directed to using certain identification codes including, for example, facility identification codes, tool identification codes, mask identification codes, pod identification codes and carrier identification codes. The Office Action fails to show where the '222 publication teaches any of these claimed codes. For example, the Office Action cites Figure 3B of the '222 publication as teaching Applicant's claimed facility identification code, but the '222 publication does not ever refer to a facility identification code. The Office Action also repeatedly cites paragraph 15 as teaching first, a processing facility, second, adding a tool identification code during an update when the mask arrives at a new tool location, and third, mask data being generated when a mask arrives a new tool location and the data is stored in a computer means. Paragraph 15 contains no discussion of updating, arriving at a tool location, a tool identification code, data generation or computer means.

The citations presented in connection with the §102 rejection are also conflicting and therefore illogical. For example, the "Current location" as shown in the table of Figure 3B refers to a reticle location, and these reticles are located in carriers. Thus, the '222 publication refers to "Current location" as the location of the reticle in the carrier. *See also*, "Cumulative time" of Figure 3B which is noted as being carrier independent, and implying that the other reticle attributes in Figure 3B are associated with the carrier (perhaps as confirmed by the underlying provisional document). The "location" citations by the Examiner are also conflicting with respect to the Examiner's own assertions of prior art correspondence to the claimed invention. Again using the "Current location" example, the Examiner alleges at pages 2-3 of the Office Action that "Current location" refers to Applicant's claimed "facility location identification codes" (page 2), and to Applicant's claimed "tool identification codes" (pages 2-3), and also to Applicant's claimed historical database (page 3, lines 2-4).

The citations in the Office Action are ambiguous, conflicting, and insufficient to support the rejection. Without complete correspondence the §102 rejection is improper and should not be maintained.

In view of the discussion above, the §103 rejection of claims 8 and 15 cannot stand as no *prima facie* case is presented and as the asserted combination of references fails to completely correspond to the claimed invention.

Applicant submits that the Office Action fails to present evidence of motivation in support of the modification of the cited '222 publication. Evidence has not been provided of any teaching or suggestion for using the '222 publication in connection with matching reticle data and wafer lot data with processing line data and storing the match data, or for modifying the reference to achieve the claimed limitations. Recent case law indicates that evidence of motivation must be specifically identified and shown by some objective teaching in the prior art leading to the modification. "Our court has provided [that the] motivation to combine may be found explicitly or implicitly: 1) in the *prior art references* themselves; 2) in the knowledge of those of ordinary skill in the art that certain *references*, or disclosures in those references, are of special interest or importance in the field; or 3) from the nature of the problem to be solved, 'leading inventors to look to *references* relating to possible solutions to that problem.'" Ruiz v. A.B. Chance Co., 234 F.3 654, 57 U.S.P.Q.2d 1161 (Fed. Cir. 2000). The Office Action fails to indicate evidence of why one skilled in the art would be led to modify the '222 publication, and

does not provide any evidence of factual teachings, suggestions or incentives from the prior art that lead to the proposed modification. Applicant requests that the rejection be withdrawn.

Further, the Office Action fails to present prior art correspondence to the claimed limitations. For example, no correspondence is provided to the limitations in claim 8 regarding "storing match data as part of the mask data set." Neither reference teaches such use of a reticle serial number associated with a wafer lot. The Office Action fails to present evidence of motivation and complete prior art correspondence to the claimed invention; therefore, the §103 rejection is improper and must be withdrawn.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is encouraged to contact the undersigned at (651) 686-6633.

Respectfully submitted,
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Dated: April 17, 2003

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